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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,393	07/18/2003	Kevin Conwell	13551	4619

7590 12/14/2004  
ORUM & ROTH  
53 W. JACKSON BLVD  
CHICAGO, IL 60604

EXAMINER

AHMAD, NASSER

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/623,393

**Applicant(s)**

CONWELL ET AL.

**Examiner**

Nasser Ahmad

**Art Unit**

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 8 and 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Koops (5824397).

Koops relates to a tire label comprising a label facestock (2) coated on a first side with pressure sensitive rubber based adhesive (4). See abstract and col. 3, lines 8-10. The facestock has a thickness of 10-2500 microns (col. 3, lines 58-600 which includes the claimed range of 0.001 to 0.008 inches. The label includes a barrier coating (3) between the facestock and the adhesive. The barrier material can be inter alia, polyamide or metal layer (col. 5, lines 26-33).having a thickness of 1 to 20 microns. The adhesive temporarily fixes rubber parts (col. 7, lines 1-4). The barrier coating inhibits migration of mobile substances from an object and/or from the adhesive (col. 3, lines 19-30), substances such as plasticizers.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-7 and 8-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koops in view of Majumdar (6221453).

Koops, as discussed above, fails to teach that the barrier coating is a polyester film, including polyethylene terephthalate (PET). Majumdar discloses a harmonic label for marking tires which includes a barrier layer to prevent migration of staining components. The barrier material can be metal, polyester, etc. (col. 3, lines 40-44). Thus, Majumdar shows that polyester and metal are equivalent barrier material known in the art.

Therefore, because these two polyester and metal are art recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute polyester for metal.

Also, the adhesive layer of Koops having a thickness of 0.001 to 0.004 inches would have been obvious, based on optimization through routine experimentation, to provide optimum adhesion of the label to a substrate.

Also, because the facestock material is the same as the claimed material, it would exhibit the claimed stiffness of 20-80 mg for enhancing conformability.

4. Claims 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koops in view of Voeller (6822582).

Koops, as discussed above, fails to teach the presence of RFID tag on the base substrate. Voeller relates to RFID tag for a tire (abstract), and that presence of alpha-numeric or bar code marking and RFID tag (col. 2, lines 8-12) are found to be functional equivalent. Therefore, because these two RFID tags and alpha-numeric/bar code marking were art-recognized equivalents at the time the invention was made, one of

ordinary skill in the art would have found it obvious to substitute RFID tags for alpha-numeric/bar code markings.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15, as stated, is found to be indefinite because it is unclear as to the location of the RFID tag with respect to the label structure.

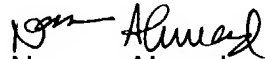
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1772

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Nasser Ahmad  
Primary Examiner  
Art Unit 1772

N. Ahmad.  
December 10, 2004.